

REMARKS/ARGUMENTS

Claims 1-98, 100, 101 stand canceled.

Claim 99

Claim 99 has been amended to recite the distinctions set forth in originally elected and examined claim 35, namely that the nanofibers have different adsorption properties than the coarse fibers. Claim 35 was rejected over Till et al. U.S. Patent 3,073,735, and over Wilson et al. U.S. Patent 6,155,432, and over Fischer U.S. Patent 5,800,706 and Kahlbaugh et al. U.S. Patent 6,521,321, with the Examiner stating with regard to each, that the applied patent is silent as to the adsorptive properties of the fibers and the nanofibers of the filter media, *however the claims are rejected as the prior art meets the chemical and physical limitations set forth in the independent claim upon which the rejected claims are dependent.*

MPEP 2144.03

Further in response, applicant respectfully notes MPEP 2144.03 indicating:

In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection. . .

MPEP 2144.03(A) states:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances.

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Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

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the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute". . .

However, MPEP 2144.03(A) further states:

We reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.

As noted in MPEP 2144.03(B):

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge.

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If such notice is to be taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.

Traverse Under MPEP 2144.03

As noted in MPEP 2144.03(C):

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

Applicant hereby respectfully but vigorously traverses such assertion and finding. Applicant specifically points to error in lack of support for the above noted official notice and alleged common knowledge without documentary evidence supporting the noted conclusion. The Examiner admits that the applied references are silent as to the adsorptive properties of the fibers and the nanofibers of the filter media, yet concludes: "*However, the claims are rejected as the prior art meets the chemical and physical limitations set forth in the independent claim upon which the rejected claims are dependent*".

Applicant has adequately traversed the Examiner's assertion, and accordingly it is respectfully submitted that documentary evidence must be provided if the rejection is to be maintained as specifically set forth in MPEP 2144.03(C):

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.

Doubt

The Examiner is further respectfully and earnestly entreated to consider that "doubt" as to patentability should be resolved in the applicant's favor. As noted in In Re Warner (1967) 54 CCPA 1628, 379 F.2d 1011, 154 USPQ 173, Cert denied 389 US 1057, rehearing denied 390 US 1000:

The "doubt" in the above cases arose from and related to the absence of facts necessary to support the Patent Office's legal conclusion of obviousness under Section 103. We think the precise language of 35 USC 102 that "a person shall be entitled to a patent unless," concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under Sections 102 and 103, see Graham and Adams. Where such proof is lacking we see no necessity for resolving doubt in favor of the Patent Office's position, for example, where, as in the above cases, the factual basis to support the legal conclusion of obviousness under Section 103 is missing, and the record there supported the applicant's position that the invention was reconstructed through hindsight. Nowhere in these cases was there the necessary factual basis to support the conclusion that it would have been obvious to one of ordinary skill to bring the elements together. United States v. Adams, supra.

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A rejection based on Section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. (emphasis added) To the extent the

Patent Office rulings are so supported, there is no basis for resolving doubts against their correctness. Likewise, we may not resolve doubts in favor of the Patent Office determination where there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness.

The Examiner is respectfully requested and earnestly entreated to consider that simplicity in application does not preclude a find of non-obviousness. Those in the art have not recognized or been motivated to applicant's combination, notwithstanding the known use of individual aspects. It may deceptively seem apparent to now combine isolated aspects as shown by applicant, but only with the aid of hindsight. There does not appear to be any suggestion of any such marriage or combination in the cited art, nor does there appear to be a reference which bridges the gap to applicant's invention. The pieces of the puzzle were present and known in the art, but never assembled together until applicant's invention. It is surprising that such a simple yet desirable combination has apparently gone unrecognized in the art. The absence of such suggestion is particularly conspicuous in a crowded art, especially in view of the age of the art and the longstanding non-recognition of the present solution; and is believed probative of non-obviousness.

Act of Cognition Or Selection

The presence in the prior art of various combinations including coarse fibers and nanofibers, yet the non-recognition of applicant's solutional combination is respectfully submitted as demonstrative evidence of non-obviousness. This non-recognition is particularly conspicuous in a crowded mature art, and is believed probative that applicant's solution involves a non-obvious act of cognition and selection required to arrive at such solution not previously recognized in the art. It is respectfully submitted that the cognition, selection and application in the present invention is novel and non-obvious and is not

recognized in the prior art. The invention requires linking association involving a cognitive step not suggested previously in the art.

As noted by the Supreme Court in United States v. Adams, 383 US 39 at 50, 148 USPQ 479, at 483 (1966), a companion case to Graham v. John Deere Company, 383 US 1, 148 USPQ 459 (1966):

"It begs the question. . .to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, the issue is whether bringing them together as taught [by the inventor] was obvious in the light of the prior art."

The act of selection is a supportable basis for invention, and is not precluded by apparent simplicity, Republic Industries, Inc. v. Schlage Lock Co., 592 F.2d 1963, 200 USPQ 769 (1979) quoting Judge Learned Hand, B.G. Corp. v. Walter Kidde and Co., 79 F.2d 20, 26 USPQ 288 (1935):

"It may be that in certain circumstances the very choice of the elements to be selected is not obvious.", Republic, page 778.

Simplicity of a combination makes the task even more difficult.

It is respectfully submitted that the burden of factually supporting a prima-facie conclusion of obviousness is not present. There is no showing, suggestion, or even hint of combining the references as proposed, nor to arrive at the defined subject matter. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, MPEP 2143.01. None of the references suggest the desirability of the proposed combination. It is respectfully submitted that there must be some motivation in the prior art

itself for combining or attempting to combine the references, particularly in view of the significant advantages resulting from applicant's combination as noted above, and the resulting enablement afforded thereby.

Further, in direct rebuttal of the Examiner's position, applicant respectfully notes In re Lee, 61 USPQ (2nd) 1433, CAFC 2002, noting that the question of obviousness requires evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. The CAFC further elaborated on this matter by explaining that the test cannot be met simply by saying that the basis for combining the references comes from "common knowledge" or is "common sense". The Examiner's position thus is not sustainable.

In re Kotzab, 55 USPC 2nd 1313, CAFC 2000, the Court commented on the need for avoiding a "hindsight syndrome". This is particularly important in cases where the very ease to which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher".

Applicant recognizes that it is a difficult if not impossible task to completely purge oneself of hindsight when attempting to place oneself in the shoes of the legal ghost called the ordinarily skilled artisan. Simplicity of a combination makes the task even more difficult. As noted above by the Supreme Court *It begs the question. . .to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, the issue is whether bringing them together as taught [by the inventor] was obvious in the light of the prior art.* The act of selection is a supportable basis for invention, and is not precluded by apparent simplicity. As noted by Judge Learned Hand, *it may be that in certain circumstances the very choice of the elements to be selected is not obvious.*

Claim 102

Amended claim 102 recites the distinctive limitations in combination previously claimed in elected and examined claim 38, namely that the nanofibers and coarse fibers have different wettability. Claim 38 was rejected over each of Till et al. '735 and Wilson et al. '432 and Fischer '706 and Kahlbaugh et al. '321, with the Examiner stating that the applied patent is silent as to the wettability properties of the fibers and the nanofibers of the filter media, *however the claims are rejected as the prior art meets the chemical and physical limitations set forth in the independent claim upon which the rejected claims are dependent.*

Traverse under MPEP 2144.03

Applicant hereby respectfully but vigorously again traverses the noted assertion and finding, and respectfully invokes MPEP 2144.03.

Claim 103

Claim 103 depends from claim 102 and recites the distinctive limitations set forth in previously elected and examined claim 39, namely that the filter media captures droplets from a liquid to be filtered, and wherein the nanofibers are preferentially wetted by the droplets, and the coarse fibers are preferentially non-wetted by the droplets, whereby to create a capillary pressure gradient wicking droplets off the coarse fibers, facilitating drainage. Consideration and allowance of claim 103 is respectfully requested.

Claim 104

Claim 104 depends from claim 102 and recites distinctive claim limitations previously set forth in elected and examined claim 40, namely that the filter media captures and coalesces droplets from a liquid to be filtered, and wherein the nanofibers are preferentially non-wetted by the droplets, and the coarse fibers are preferentially wetted by the droplets, whereby to create a capillary pressure gradient wicking droplets off the


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nanofibers, facilitating coalescence and drainage. Consideration and allowance of claim 104 is respectfully requested.

Consideration and allowance of this application with claims 99, 102-104, is respectfully requested.

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

A handwritten signature in cursive script, appearing to read "Michael E. Taken", followed by a horizontal line.

Michael E. Taken
(Reg. No. 28,120)

100 East Wisconsin Avenue, Suite 1100
Milwaukee, Wisconsin 53202
(414) 271-7590